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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,684	12/22/2000	Sridhar Iyengar	42390P10467	1658

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EXAMINER
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GOLD, AVI M

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/746,684

**Applicant(s)**

IYENGAR ET AL.

**Examiner**

Avi Gold

**Art Unit**

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This action is responsive to the amendment filed on March 25, 2005. Claim 10 was amended. Claims 1-25 are pending.

### ***Response to Amendment***

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 24 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not disclose a transitory selectable item.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10 and 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. The use of "comprises selected ones of:" makes the claim indefinite and vague.

6. The term "transitory selectable item" in claim 24 is a relative term which renders the claim indefinite. The term "transitory selectable item" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 6-11, and 14-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al., U.S. Patent No. 6,343,318 further in view of Sachs et al., U.S. Patent No. 6,331,865.

Hawkins teaches the invention substantially as claimed including low bandwidth network access to Internet based information (see abstract).

As to claim 1, Hawkins teaches a method for a handheld device to facilitate interaction with a viewing device receiving a broadcast, comprising:

indicating with the handheld device interest in content in a first data format provided by a content provider (col. 3, lines 32-48, Hawkins discloses predefined

applications and data formatted according to a first markup language; col. 2, lines 2-5, Hawkins discloses a user request for a site that supplies restaurant reviews);

receiving the content from a formatting agent (col. 2, lines 2-5, col. 3, lines 32-48; Hawkins discloses a client receiving content from a server);

selecting content in the content having the first data format (col. 2, lines 2-5, col. 3, lines 32-48; Hawkins discloses a client generating queries); and

receiving said selected content from the formatting agent in a second data format compatible with the handheld device (col. 2, lines 2-5, col. 3, lines 32-48; Hawkins discloses responses formatted to a second markup language).

Hawkins fails to teach the limitation further including indicating with the handheld device interest in a content catalog identifying content.

However, Sachs teaches a digital content distribution system and method which are capable of preventing unauthorized subsequent distribution of the digital contents (see abstract). Sachs teaches the use of a catalog of distinct digital contents (col. 2, lines 34-37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hawkins in view of Sachs to use a handheld device with interest in a content catalog identifying content. One would be motivated to do so because it allows the user to easily view all of the available contents from a content provider.

Regarding claim 2, Hawkins teaches the method of claim 1, wherein the handheld device comprises a wireless coupling to the formatting agent (col. 3, lines 49-

52; Hawkins discloses a handheld computer with wireless communication between the client and server).

Regarding claim 6, Hawkins teaches the method of claim 1, wherein the first data format is incompatible with the handheld device, the method further comprising:

retrieving said selected content from the content provider (col. 3, lines 32-48);  
converting by the formatting agent of the first data format into the second data format (col. 3, lines 32-48);

Regarding claim 7, Hawkins teaches the method of claim 1, further comprising:  
retrieving by the formatting agent of said selected content from the content provider (col. 3, lines 32-48);

determining the first data format is incompatible with the handheld device (col. 3, lines 32-48); and

converting said selected content into said compatible second data format (col. 3, lines 32-48; col. 10, lines 1-17).

Regarding claim 8, Hawkins teaches the method of claim 1, wherein said converting comprises:

determining characteristics of the handheld device (col. 10, lines 1-17; Hawkins discloses appropriate size and bit depth for display in a wireless communication device);

identifying a portion of said selected content that is incompatible with the handheld device (col. 10, lines 1-17; Hawkins discloses size and bit depth that need to be converted); and

wherein said receiving said selected content from in the second data format includes converting said incompatible portion into a compatible portion based on said determined characteristics (col. 10, lines 1-17; Hawkins discloses converting image contents).

Regarding claim 9, Hawkins teaches the method of claim 7, wherein said incompatible portion comprises an Internet communication protocol (col. 10, lines 1-17; Hawkins discloses conversion of Internet protocols and content into a form that can be used by the wireless communication device).

Regarding claim 10, Hawkins teaches the method of claim 1, wherein the content catalog comprises selected ones of: links to content provider content, and embedded content provider content (col. 6, lines 33-47; Hawkins discloses various types of content).

Regarding claim 19, Hawkins teaches the system of claim 18, wherein the first data format is the same as the second format (col. 9; lines 29-51; Hawkins discloses the use of CML at both locations).

Regarding claim 20, Hawkins teaches the system of claim 18, wherein said second instructions include further instructions for converting the first data format into the second data format (col. 3, lines 32-48; col. 10, lines 1-17).

Regarding claim 21, Hawkins teaches the system of claim 18, further comprising:  
a content provider communicatively coupled to the formatting server (col. 3, lines 32-48);

wherein said first instructions include further instructions, which when executed by the handheld device, direct the handheld device to retrieve content from the content provider (col. 3, lines 32-48).

Regarding claim 22, Hawkins teaches the system of claim 21, wherein said instructions include further instructions, which when executed by the handheld device, direct the handheld device to:

display the catalog on the handheld device (col. 3, lines 32-48);  
receive a selection of a catalog entry corresponding to content provided by a content provider (col. 3, lines 32-48); and  
retrieve said content from the content provider (col. 3, lines 32-48).

Regarding claim 23, Hawkins teaches the method of claim 1, wherein the content identified in the content catalog changes in accord with changes of material present in



the broadcast (col. 1, lines 35-40, lines 49-55, Sachs discloses a catalog of distinct digital contents based on the contents of a virtual bookstore).

Regarding claim 25, Hawkins teaches the method of claim 24, wherein the formatting agent is disposed within the viewing device (col. 20, lines 13-27, Hawkins discloses content rendered on the wireless client).

Claims 11, 14-18, and 24 do not teach or define any new limitations above claims 1 and 6-8 and therefore are rejected for similar reasons.

9. Claims 3-5, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins and Sachs further in view of Dunn et al., U.S. Patent No. 6,154,772.

Hawkins teaches the invention substantially as claimed including low bandwidth network access to Internet based information (see abstract).

As to claim 3, Hawkins teaches the method of claim 1.

Hawkins fails to teach the limitation further including the content catalog content corresponding at least in part to broadcasts available for receipt by the viewing device.

However, Dunn teaches a system and method for the delivery of digital video and data over a communication channel (see abstract). Dunn teaches the use of content available in broadcasts (col. 18, lines 4-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hawkins in view of Dunn to use the content catalog content corresponding at least in part to broadcasts available for receipt by the viewing device. One would be motivated to do so because broadcasted content is easily transferred.

As to claim 4, Hawkins teaches the method of claim 1.

Hawkins fails to teach the limitation further including broadcasting the broadcast to the viewing device over a communication channel; determining broadcast-related data for the broadcast; and making said broadcast-related data available to a content initiator so that the content initiator associates said broadcast related data with the content catalog.

However, Dunn teaches a system and method for the delivery of digital video and data over a communication channel (see abstract). Dunn teaches the use of a communication channel for broadcasting content and available digital video content (col. 18, lines 4-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hawkins in view of Dunn to broadcast the broadcast to the viewing device over a communication channel; determining broadcast-related data for the broadcast; and making said broadcast-related data available to a content initiator so that the content initiator associates said broadcast related data with the content catalog. One would be motivated to do so because it allows the broadcasted content to be sent

to the viewing device and the content catalog to have information regarding said broadcasted content.

As to claim 5, Hawkins and Dunn teach the method of claim 4.

Hawkins fails to teach the limitation further including the providing, by a broadcaster, said broadcast-related data to a content provider so that the content provider makes said broadcast-related data available to the content initiator.

However, Dunn teaches a system and method for the delivery of digital video and data over a communication channel (see abstract). Dunn teaches the use of hundreds of channels on a broadcast backplane (col. 18, lines 4-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hawkins in view of Dunn to provide broadcast-related data to a content provider so that the content provider makes said broadcast-related data available to the content initiator. One would be motivated to do so because it allows the user to choose from content that is broadcasted.

Claims 12 and 13 do not teach or define any new limitations above claims 4 and 5 and therefore are rejected for similar reasons.

### ***Response to Arguments***

10. Applicant's arguments filed March 25, 2005 have been fully considered but they are not persuasive.

Regarding the argument to claim 1, the applicant argues that the reference, Hawkins, does not disclose indicating with the handheld device interest in obtaining content. The examiner disagrees, as seen in, column 2, lines 2-5, there is a user request for a site that supplies restaurant reviews.

Regarding the argument to claims 3 and 4, the applicant argues that the reference, Dunn, does not properly disclose the limitations of claims 3 and 4. The examiner disagrees, as seen in, column 18, lines 4-49, there is program content that is available to users, over a broadcast, to view on a viewing device; said broadcast being sent over a communication channel; different content being chosen for broadcast; and the communication channel that links the central office to the customer premise (which inherently involves a content initiator that makes available for an end user an easy way to view available programming content). This in combination with the Hawkins and Sachs references properly discloses the limitations of claims 3 and 4.

11. In response to applicant's arguments, the recitation regarding a method or system for a handheld device to facilitate interaction with a viewing device receiving a broadcast in claims 1, 18, and 24 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

12. In response to applicant's arguments against the references individually, in claim 1, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The arguments state that Hawkins does not disclose receiving the content catalog. The examiner has already agreed with this as shown in the 103 rejection where Sachs discloses a content catalog.

### **Conclusion**

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,574,660 to Pashupathy et al.

U.S. Pat. No. 6,317,795 to Malkin et al.

U.S. Pat. No. 6,259,405 to Stewart et al.

U.S. Pat. No. 6,671,715 to Langseth et al.

U.S. Pat. No. 6,166,778 to Yamamoto et al.

U.S. Pat. No. 6,567,660 to Wegener et al.

U.S. Pat. No. 6,088,455 to Logan et al.

U.S. Pat. No. 6,412,112 to Barrett et al.

U.S. Pat. No. 6,587,835 to Treyz et al.

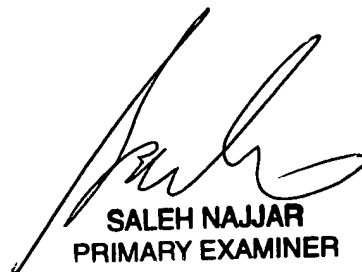
U.S. Pat. No. 6,457,047 to Chandra et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 571-272-4002. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**PRIMARY EXAMINER**